JOHN T. FEY, Cl

IN THE

Supreme Court of the United States

October Term 1956

No. 333

SALES AFFILIATES, INC.,

Petitioner,

vs.

HELENE CURTIS INDUSTRIES, INC., HELENE CURTIS SALES, INC., THE GILLETTE COMPANY, *et al.*,

Respondents.

PETITION FOR A WRIT OF CERTIORARI

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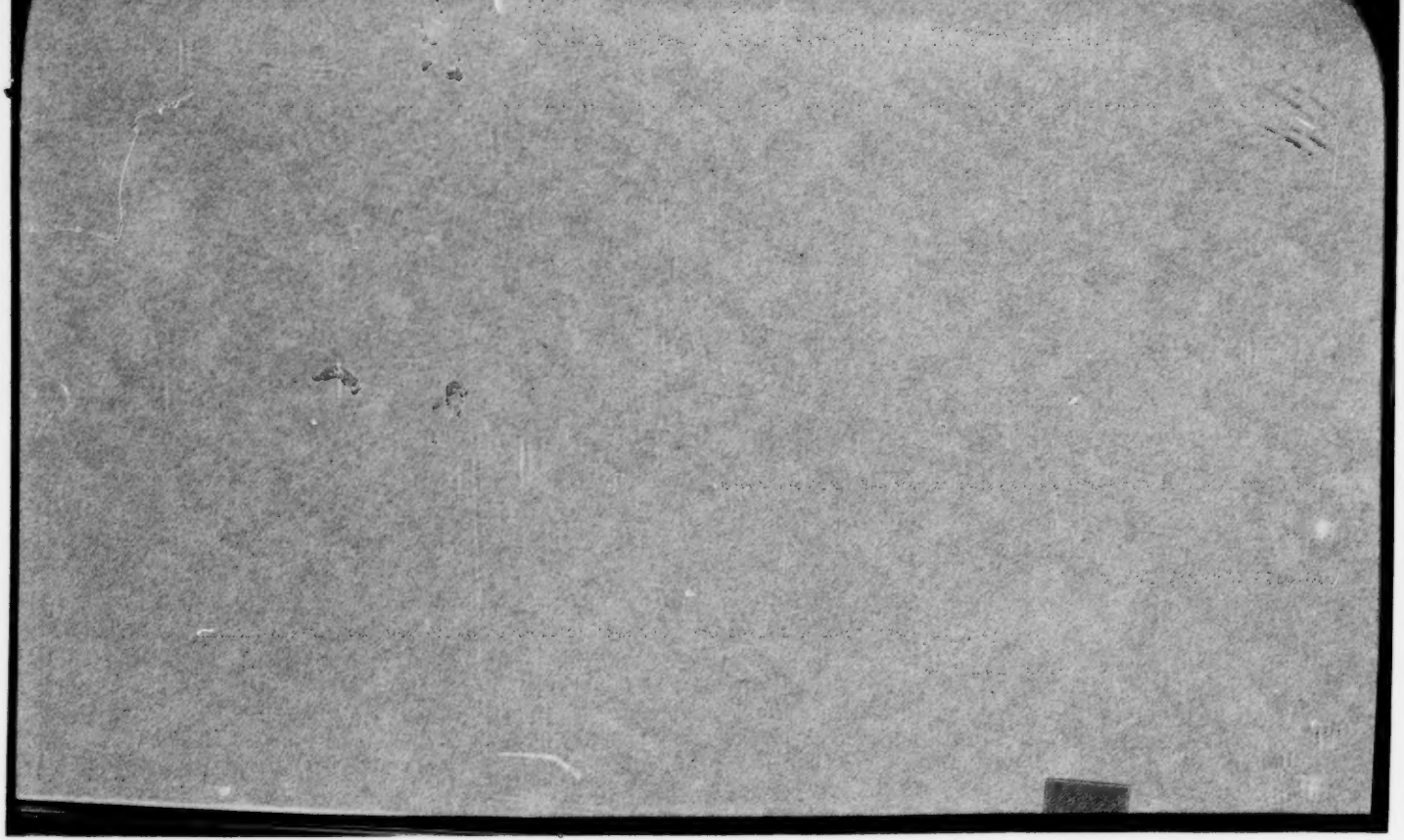

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List of Abbreviations

D.A.—Petitioner's appendix to brief before Court of Appeals for Second Circuit

P.A.—Respondents' appendix to brief before Court of Appeals for Second Circuit

D.A.E.—Exhibits printed in petitioner's appendix before Court of Appeals for Second Circuit

D.X.—Petitioner's exhibit

P.X.—Respondents' exhibit

D.A. ...B—Petitioner's additional appendix "B" of papers re counterclaim against Helene Curtis involving "protest" against issue of McDonough patent

p.....a—Petitioner's appendix to this petition

Petitioner or defendant—Sales Affiliates, Inc.

Respondents or plaintiffs—all parties other than Sales Affiliates, Inc.

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Respondents.

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To: *The Honorable Chief Justice and*
The Associate Justices of the United States

Your petitioner, Sales Affiliates, Inc., prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit in the above identified cases.

These four cases all involve identical questions relating to validity of the McDonough patent No. 2,577,710. The first case involves as well a counterclaim by petitioner against respondent, Helene Curtis Industries Inc., for malicious interference with petitioner's business relations.

All cases and counterclaims were tried and submitted on one record in the courts below. The Court of Appeals' judgment affirmed the four decrees of the District Court confirming the Report of the Special Master holding the patent invalid but infringed, and dismissing the counterclaim of petitioner.

The patent covers new compositions of matter for permanent waving of human hair. It is printed at D.A. E81.

Opinions Below

The report of the Special Master is printed at page 2952 of petitioner Sales Affiliates, Inc.'s appendix in the Court of Appeals. The opinion of the District Court is reported in 121 F. Supp. 490 and is printed at page 3223 of petitioner Sales Affiliates, Inc.'s appendix in the Court of Appeals. The opinion of the Court of Appeals appears in 233 F. 2d 148 and is printed in the Appendix hereto.

Jurisdiction

The judgment of the Court of Appeals was dated and entered on April 9, 1956. The judgment of the Court of Appeals denying Sales Affiliates' petition for rehearing is dated May 8, 1956.

By Order of Mr. Justice Harlan of this Court dated July 25, 1956, the time within which to petition for certiorari was extended to and including August 20, 1956.

Jurisdiction of this Court is invoked under 28 U. S. C. 1254.

Questions Presented

1. Is petitioner denied due process of law in violation of the Fifth Amendment to the U. S. Constitution by being deprived of oral summation before a Special Master, in a case involving a six months' trial, over 6000 pages of testimony and several thousand pages of exhibits raising complex and complicated issues of law and fact when such issues were still judicially unfettered by the operation of Rule 53(e) (2) of the Federal Rules of Civil Procedure?

2. Does the direct conflict between the Second Circuit holding below that the patent in suit is invalid and the holding of validity by the District Court for the District of Columbia which ordered the U. S. Patent Office to issue the patent create such uncertainty in Patent Office administration and such confusion in a $100,000,000 a year industry as to require settlement by this Court?

3. Is a Canadian patent, typewritten but not printed, disclosing subject matter in its specification which is not claimed in the patent, an anticipation of a United States patent within the meaning of 35 U. S. C. 102(b)?

4. Regardless of prior art teachings, or lack thereof, must a biochemical invention consisting of a new composition of matter nevertheless be bound by precipitous limits, beyond which no results of the invention can be obtained, in order to be patentable as the Second Circuit held below; or, in accordance with the Sixth Circuit rule and the *Expanded Metal* and *Mineral Separation* decisions of this Court, is such biochemical composition patentable if it displays inventive results over the prior art?

5. Can genus claims be invalidated by use or knowledge of a species by another prior to completion of the invention of the genus but after the invention of the same species by the patentee?

6. Can there be double patenting between the claims of a patent limited to hair waving without damage over the claims of a depilatory patent limited to hair destruction?

7. Whether an inventor who abandons or dedicates part of his invention must be more precise than the inventor who claims his invention to the hilt?

8. Can the Court of Appeals ignore the provisions of 35 USC 135 and 37 Code of Federal Regulations 1.201(a) and (b) which bound the Patent Office Examiner in his conduct to make a finding that the patent application contained patentable subject matter before declaring an interference and hold that there was no evidence that the Patent Office had made such a determination when the undisputed evidence established that the Examiner did in fact declare an interference?

9. Did the lower Courts perform their proper judicial functions:

(a) When the Courts found no causation based on the false premise that the Patent Office had neither formally allowed the patent application nor indicated that it was formally allowable in the face of undisputed evidence that (1) Respondent Helene Curtis admitted that the application contained allowable claims, (2) Patent Office Examiner's written record showed the application contained allowable claims, (3) the testimony of an expert in Patent Office procedure and

practice interpreting the language of the established Patent Office Action that the application contained allowable claims?

(b) When the Court ignored undisputed evidence that the protest contained misrepresentations of fact and held that no misrepresentations were shown?

(c) Where the lower court ignored the law as to the standard of conduct required by parties appearing before the Patent Office and held that a little false swearing is to be expected?

Constitutional Provision and Statutes Involved

"No person shall be * * * deprived of * * * property, without due process of law" U. S. Const., 5th Amend.

28 U. S. C. §1254;

35 U. S. C. (1952) §22, 102(a), (b), (e) and (g), 135 *;

Revised Statutes 4886, 4887*, 4915;

Federal Rules of Civil Procedure, Rule 53(e), (1), (2), and (5)*;

37 Code of Federal Regulations 1.201 (a) and (b) and 1.291 *.

* Printed in Appendix at pages 41a-46a.

Statement

These are four cases consolidated for trial and appeal below, involving as their common subject matter validity and infringement of U. S. Letters Patent 2,577,710. Civ. No. 71-280 (*Helene Curtis* v. *Sales Affiliates*) additionally involves a counterclaim for malicious interference with prosecution of the patent in the Patent Office. Petitioner is the owner of the patent. All other parties to the litigation are accused infringers, with the exception of involuntary plaintiff, Procter & Gamble, in Civ. No. 76-375 and 376 (who did not appear).

The invention of the patent is directed to new compositions of matter in the old art of permanent waving of human hair and is uniquely effective for "cold waving".

Until very recent years, women had their hair permanently waved by professional operators. A great deal of heat of extremely high temperatures was required, originally with cumbersome and dangerous electric heating machines and in later years with exothermic chemicals. Heat was necessary because the chemical agents used to soften the hair prior to changing its configuration—such as ammonia and borax—depended upon a chemical reaction called "hydrolysis" which took place only at the high temperatures (D.A. 2959). These heat-treated permanent waves were imparted in 3 to 30 minutes (D.A. 1960, 1996).

Attempts to wave without heat, with one exception, were failures because the waving effect was achieved only after hours or days of application. These were largely with solutions of alkaline inorganic sulfites (D.A. 2959-60). The exception occurred in 1940 when Arnold Willat began to market solutions of ammonium hydrogen sulfide. This material was extremely toxic and had the odor of rotten eggs. It required costly equipment to protect patrons from odors and toxicity; but, like the hot methods, it waved

hair without heat in a matter of minutes (D.A. 2100, 2960, E978). Because of the long-existing demand for "cold waving", use of the Willat solution spread rapidly throughout the nation, but in April 1941 a woman died in Atlanta of hydrogen sulfide poisoning while receiving a Willat wave and the Federal Food and Drug Administration prohibited its further use (D.A. 2960).

On June 16, 1941 McDonough's application for the patent in suit was filed in the Patent Office; and, on the following day, June 17, 1941, the invention claimed therein was publicly used in the Willat system, in place of the Willat solution, in Gimbel's department store, a licensee of Willat (D.A. 296, 2442). This substitution was approved by Willat (D.A. 127), who had gone for help to the inventor herein, Dr. McDonough, requesting from him a non-toxic waving composition which could be used in the Willat process, after the occurrence of the Atlanta tragedy (D.A. 125-126). This was the first commercial use of any mercaptan waving composition (D.A. 2961).

The patented composition of matter thereby first introduced to the world can be summarized as follows:

(a) A solution of a substituted mercaptan* having molecular weights below 121;

(b) Containing a "weak" base, *i.e.* an alkaline material with a dissociation constant less than 5×10^{-3};

(c) The relative quantities of mercaptan and base being such that the pH ** of the solution is above 7 and not greater than 9.5; preferably about pH 9.2.

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* Mercaptans are a class of *organic thioalcohols.* They have been known as chemicals since 1900 but had had little practical use (D.A. 292).

** pH is the chemist's shorthand scale for acidity and alkalinity. The tota' scale is 1 to 14. The higher the pH the more alkaline the solution, and the lower the pH the more acidic.

In his patent McDonough taught that his new mercaptan solutions had very powerful waving effects on human hair. He discovered and disclosed that such solutions were capable of waving without heat, in minutes, without toxicity, and without disagreeable odors. He also discovered there was a race between waving and imminent damage or destruction of the hair. At pH's above 10.0 the damaging effect might win the race before a satisfactory wave was achieved and in order to insure a time latitude sufficient for safe waving without hair damage, he warned the art to maintain the pH below 9.5 (D.A. E81).

The achievement performances of this invention are outstanding and unexpected in the light of the art. The patented invention is today the *only* composition of matter used for permanent waving of women's hair (D.A. E1412-1425). Sales in the United States total more than $100,000,000 per year and the patented composition is used universally throughout the world with faithful adherence to McDonough's teachings (D.A. 2961, E1412, E1425). The entire industry of "home waving", wherein cold waving kits are sold at retail for amateur use (comprising the major volume of sales in the United States), came into being after the invention and is based precisely thereon (D.A. 2961).

Technically, new and unexpected results of the invention are these:

(a) Cold waving was made possible and can be safely performed in the same order of time as the former hot waving, that is, in treatment times of 5 to 30 *minutes*, as contrasted with the only prior non-toxic composition which required 4 to 24 *hours;*

(b) The patented compositions are non-toxic and safe for use by amateurs, whereas the only prior com-

position capable of cold waving with similar speed was fatally poisonous;

(c) By minor variations of ingredient concentrations within the claimed ranges, large variations in speed and tightness of waving can be achieved without hazard to the health and comfort of the user or harm to the hair structure.

These controls in speed and effectiveness of the composition accommodate the invention to the treatment of human hair on the living scalp under a wide variety of procedures and conditions. Because of its biological origin and the great variety of conditions and treatments to which modern women's hair is subjected, such hair has infinite variability in strength, resistance to waving and susceptibility to damage (D.A. 2979).

The patent was issued as the result of a suit against the Commissioner of Patents under R.S. 4915 in the District Court for the District of Columbia (D.A. E1581). The Commissioner appealed from that decision but the appeal was withdrawn before adjudication and the patent granted after some minor modification in the adjudicated claims. The instant cases arose by way of actions in the U. S. District Court (S. D. N. Y.) for declaratory judgment filed the day the patent issued.

Trial was held before a Special Master, the testimony lasting six months. At its close all parties requested oral argument and the Master agreed to provide it (p. 29a). Main briefs and reply briefs were filed within five months thereafter. An additional seven months later, without hearing oral argument, the Master handed down his Report finding the patent infringed but invalid, which was confirmed by the District Court and the Court of Appeals for the Second Circuit.

Summary of Argument

1. The trial of these cases, before a Special Master, required six months' time, over six thousand pages of testimony and an almost equally voluminous set of exhibits. Petitioner requested and the Master agreed to hear oral argument after the briefs had been filed and the Master had studied them and the evidence. The Master promised to inform counsel whether *he* would want argument on any particulars when he had reached that point, but petitioner's counsel reserved the right to argue nevertheless. Instead, a year after the trial ended the Master filed his report without communicating with counsel or permitting *any* argument.

Petitioner was thus deprived of any oral summation and the advantages of forensic presentation at any time before the Master's findings were made and became subject to the "clearly erroneous" provisions of Rule 53(e) (2). This deprivation was a violation of due process under the 5th Amendment, the decisions of this Court and the prevailing customs and practices of common law.

2. The patent in suit resulted from the decision of the U. S. District Court for the District of Columbia under R.S. 4915. The findings of fact and conclusions of law therein are binding on the Patent Office and govern the administration thereof as to the patent in suit and a series of related patents. Those findings and conclusions are diametrically in conflict with the controlling findings and law of the Second Circuit in the case at bar. The corrective jurisdiction of this Court is required to straighten out the confusion which has country-wide implications in a very large industry.

3. A typewritten (not printed) prior Canadian patent was held to bar the patent in suit under 35 U. S. C. 102

(b), although the invention was not *patented* therein and it was not a *printed* description thereof. The holding is contrary to rulings of this Court, and it is in conflict with the holding on this point of the Sixth Circuit. The corrective jurisdiction of this Court is invoked to clarify and settle an important point of patent law.

4. The destruction of petitioner's patent is based on an over-technical application of the law of "criticality" in violation of prevailing decisions of this Court and in conflict with the rule in the Sixth Circuit. Great harm will be done by letting the Second Circuit doctrine stand, especially in the adjudication of patents in the biochemical field, where sharply defined *points* are not proper or realistic criteria for distinguishing inventions and their results. The Court of Appeals has set forth as law a reprehensible rule requiring a comparison of the results of the patented compositions with each other instead of against the results of the prior art.

5. The genus claims of the patent in suit were held anticipated by prior use of a species in disregard of the fact that the patentee, McDonough, had reduced that same species to practice long before the intervening user. The intervening use was therefore not "prior" because its subject matter had already been invented by McDonough. This holding is contrary to the established practice and decisions of the Patent Office. Its correction by this Court is required to clarify the rights of inventors of genus and species inventions, especially in the chemical field.

6. A novel and erroneous doctrine of "double patenting" was promulgated by the Master and affirmed by the Courts below. The claims of the patent in suit are limited in terms and elements to waving hair without damage,

yet the Courts below held that they express the same patent monopoly as prior claims for a depilatory composition for destroying hair. This false doctrine requires the corrective action of this Court to preclude the error from becoming established in the patent law.

7. Because portions of the instant invention were dedicated and abandoned to the public each of the claims here involved is more narrow than the broader invention expressed in the patent specifications. If the inventor here had claimed his monopoly to the hilt, the Court of Appeals below would have permitted language to be used in those claims having some degree of approximation. However, because there had been abandonment and dedication the Court of Appeals stated language of greater precision was required and the Court struck down the claims. This is a mischievous doctrine of law which requires the corrective action of this Court to prevent stifling of the incentives necessary for advancement of the science and art.

8 & 9. The Court of Appeals affirmed the dismissal of the counterclaim for malicious interference with petitioner's patent application on the ground that the record did not disclose that the Patent Office had ever indicated that the claims of the application were allowable. This ignores the meaning of 35 U. S. C. 135 and 37 C. F. R. 1.201(a) and (b) as well as the undisputed facts of the record. As a result of this error the Court of Appeals held that petitioner had failed to establish causation between the conduct of the respondent Helene Curtis and the injury to the petitioner. This ruling is in direct conflict with the undisputed facts establishing causation pointed out to that Court. The granting of this writ of certiorari is necessary in order to correct the departure of the lower courts from recognized judicial procedure.

ARGUMENT

Question 1. Is petitioner denied due process of law in violation of the Fifth Amendment to the U. S. Constitution by being deprived of oral summation before a Special Master, in a case involving a six months' trial, over 6000 pages of testimony and several thousand pages of exhibits raising complex and complicated issues of law and fact when such issues were still judicially unfettered by the operation of Rule 53 (e) (2) of the Federal Rules of Civil Procedure?

(a) *The Facts*

The Court of Appeals found that it was undisputed that counsel for petitioner (a) had requested oral argument; (b) that oral argument would be heard by the Master and the time for such argument would be fixed by agreement with counsel for both sides and the Master some time after the briefs were submitted to the Master; (c) that petitioner's counsel and respondents' counsel met on May 14, 1953 with the Master to ascertain a date for oral argument; (d) that at that meeting the Master stated "after he (the Master) had studied the briefs and record he would advise counsel *if he, the Master, wanted oral argument* on any matter but that this should not preclude counsel from making argument generally or on any points they might wish to discuss; (e) that no additional request for oral argument was made thereafter; (f) the reply briefs were exchanged on June 15, 1953; (g) that the Master's report was filed January 13, 1954 without prior communication with the parties (pp. 29a, 30a).

These facts establish that petitioner's counsel requested oral argument, was promised by the Master that the opportunity for oral argument would be given, attended a

later meeting and was told by the Master that the *Master would advise counsel* **after he had studied the briefs and record, of the Master's desire for oral argument.** The Master never advised counsel that the Master did or did not desire oral argument. By this failure, he effectively suppressed any opportunity for oral argument. The first communication had by the Master with the parties after the May 14, 1953 meeting was the submission of the Master's report on January 13, 1954. *The Master never advised counsel that he had completed his study of the briefs and record in the case.* Nor were counsel for petitioner lax in failing to ascertain when the Master had completed his study of the briefs and record inasmuch as it was public knowledge from the press that the Master, as chief-trial counsel, was actively engaged in two large cases extending from about June 30, 1953 to December 13, 1953 (D.A. 3223-3227). It was not incumbent upon counsel to harass or embarrass the Master with inquiries as to whether he had completed his task of studying the record and briefs.

(b) *The District Court Holding*

The District Court devoted a major section of its opinion to the binding effect of the Master's findings under Rule 53(e) (2), stating that said findings were "armored with a strong presumption of validity", 121 F. Supp. 495.

The District Court then held that absence of oral argument was "insubstantial in view of the extensive arguments that *have* been heard"—referring to the arguments before the District Court *after* the Master's Report had been filed (D.A. 3232 footnote).

(c) *The Holding of the Court of Appeals*

In spite of its acknowledgement of the foregoing undisputed facts, the Court of Appeals held that petitioner had a fair trial because (a) after the May 14 meeting counsel for petitioner never further notified the Master (during his study of the briefs and record) that it demanded oral argument; (b) that petitioner did not assert it was denied an opportunity to present any arguments to the Master not contained in its briefs; and (c) that no petition for reconsideration was made before the Master and the point was not argued either orally or in the briefs before the District Court (pp. 30a-31a).

With respect to (a), counsel for petitioner properly awaited advice from the Master as to the completion by the Master of his study of the briefs and record. Until that advice petitioner could not know that it would have to insist on oral hearing *sua sponte*, particularly since it had already twice requested oral hearing. No counsel is expected to prod the Court when it is engaged in studying briefs and records—particularly when it is shown that the Court has been engaged in other matters.

Reason (b) ignores the recognized differences between the two forms of argument and accepts the false premise that the effect of the two forms of argument is the same. While it is true that voluminous briefs were filed before the Master by all parties (totalling in all almost 1000 pages) the briefs of the petitioner were written in the light of the expectation and assurance of being accorded an oral argument which had been demanded by petitioner and promised by the Master before submitting his final report (p. 29a). It is admitted by the Court of Appeals that there was no oral argument before the Master (p. 30a).

It is not enough to say in a complicated case of this type that argument in briefs was adequate. The mere fact

that parties litigant are usually and customarily afforded the right to both oral and written argument in a case of this magnitude is a recognition of the fact that there is, in fact, a distinct and important difference between the two forms of presentation. If oral argument is the equivalent of written argument there never would be a necessity of having both and only one of the two forms would in all cases suffice. As we argue below, our adversary system of the administration of justice recognizes that a proper oral argument exercises persuasive powers impossible of exertion by the printed page. This fact is even more apparent when the printed page is written in contemplation of oral argument.

Petitioner shows *infra* that there are many cogent arguments which it could have presented orally which were not contained in its briefs.

Reason (c) ignores the practical matter that on January 13, 1954 the Master presented the parties with a *fait accompli* of 121 printed pages in the form of a report which represented the crystallized thinking of the Master unaided by oral argument. He did not submit a draft report to counsel as provided in Rule 53(e) (5) nor otherwise indicate he had completed his review of briefs and evidence. Reason (c) further ignores the fact that the powers of the Master were exhausted when he filed his report so that a rehearing could not have been granted by him under the Rules nor the order of reference, *cf.* Rule 53(e) (1) and (2). Reason (c) is further plainly inaccurate when it charges petitioner with failing to insist upon this error before the District Court. The second objection to the Master's report prominently raised this grievous error (D.A. 3090). The briefs before the District Courts pointed out that the District Court's request for brevity was being respected and matters not specifically covered in the brief

were being insisted upon and were delineated in more detail in the Objections to the Master's Report.

It is apparent that the reasoning of the Court of Appeals to justify deprivation of oral argument is clearly erroneous.

(d) *The rule of the* WJR *case, applied to the circumstances of the case at bar, requires oral hearing.*

The Court of Appeals held, after referring to the statement of *Federal Communications Commission* v. *WJR etc.*, 337 U. S. 265, 274-277, that the requirements of due process be decided on a case-by-case basis, that petitioner "had been accorded all the requirements of a fair and proper trial" (p. 31a). However, the Court below ignored substantially all of the principles set forth by this Court in the *WJR* case as controlling in determination of such question.

Every factor found lacking in the *WJR* case under the criteria there set forth by this Court for requiring oral argument as an essential of due process is present in the instant case.

The *WJR* case involved the right to make oral argument on an issue raised by a pleading tantamount to a demurrer. This Court held that the factors to be considered are (1) the particular interest affected, (2) circumstances involved and (3) procedures prescribed by Congress for dealing with them—337 U. S. 277. This Court properly held that measured by the criteria, the facts in the *WJR* case did not satisfy the requirement for oral argument as an essential element of due process.

(1) Unlike the *WJR* case which involved two pleadings and nothing else, this case was long and fully developed.

The testimony was taken over a period extending from July 1952 to the middle of January 1953 (D.A. 2956). The record before the Master contained over 6000 pages of testimony and the more than 1000 exhibits exceeded several thousand pages.

(2) Unlike the *WJR* case which involved no factual issues, this case involved complex and difficult scientific questions of fact. As stated by the District Court in its opinion, "Many of the factual issues are of a scientific nature and a determination of these issues required the digesting of literally thousands of pages of documentary evidence"—121 F. Supp. 490 at 494.

(3) Unlike the *WJR* case which involved one simple legal issue, this case involved many and varied principles of law. The Master correctly stated that the pleadings attacked the validity of the patent in suit "on almost every ground known to the patent law" (D.A. 2954).

(4) Unlike the *WJR* case which involved an administrative agency and where Congress had specifically prescribed oral argument for a later stage of the proceedings not yet reached, neither Congress nor this Court has limited oral argument to any particular phase of full-fledged judicial proceedings as in the instant case—neither by statute, Federal Rule, or otherwise. Congress has left the necessity for oral argument in court proceedings to the demands of custom and usage that are recognized by the common law to constitute the rudimentary essentials of fair play. In the case at bar, petitioner was deprived of oral hearing at the very crossroads of the case, the summation of the evidence after trial had closed and before the Master had made his findings of fact. Summation afforded thereafter was tantamount to locking the barn door after the horse was gone.

(5) Unlike the *WJR* case where all of the courts were convinced that the interest of *WJR* was contingent or speculative or non-existent, the interest of the petitioner in the instant case was a valuable property right embodied in the letters patent in suit. Two of the instant consolidated cases were declaratory judgment actions asking for forfeiture of the patent and the other two cases asked for the same destruction of petitioner's property by way of counterclaim.

(e) *Due process requires oral argument under the facts of the present case.*

In reaching its conclusion the decision of the Court of Appeals is in conflict with this Court's decision in *Londoner* v. *Denver*, 210 U. S. 373, 28 S. Ct. 708 where it was held that oral argument was essential to a fair hearing in a case involving the validity of a tax assessment, and in conflict as well with this Court's decision in *Morgan* v. *United States*, 304 U. S. 1, 58 S. Ct. 773, where this Court held, in a case involving an administrative determination by the Secretary of Agriculture pursuant to Packers and Stockyards Act of 1921, that:

> "Congress, in requiring a 'full hearing', had regard to judicial standards—not in any technical sense but with respect to those fundamental requirements of fairness which are of the essence of due process in a proceeding of a judicial nature. * * * The requirements of fairness are not exhausted in the taking or consideration of evidence, but extend to the concluding parts of the procedure as well as to the beginning and intermediate steps." 304 U. S. 19-20.

The importance of summation by oral argument of a cause on its merits before the trier of fact is well established in the judicial procedure of this country. Its denial is always reviewed with great care. In many jurisdictions the right is absolute*—in the others, denial of oral argument under the circumstances here presented would be plain abuse of judicial discretion.**

The necessity for oral argument has been emphasized by leading jurists. Mr. Justice Harlan in his address to the Judicial Conference of the Fourth Circuit on June 24, 1955 described the part played by oral argument in appellate practice in these terms:

> "For my part, there is no substitute, even within the time limits afforded by the busy calendars of modern appellate courts, for the Socratic method of procedure in getting at the real heart of an issue and in finding out where the truth lies" *41 Cornell Law Quarterly 6*, Fall 1955. (Further extracts found in Appendix, 39a-41a.)

In this connection see also *"Oral Argument on Appeal"* by U. S. Circuit Judge Harold R. Medina, American Bar Assn. Journal Vol. XX, No. 3, pp. 139, 140, March 1934 and *"Forensic Persuasion"* by Arthur T. Vanderbilt (Chief Justice of New Jersey), Washington & Lee Law Review, Vol. VII, No. 2, pp. 123, 124 (1950).

Mr. Chief Justice Vinson, while sitting as an associate Justice of the Court of Appeals for the District of Colum-

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* *State* v. *City of Milwaukee*, 157 Wisc. 511, 512; 147 N. W. 52-3; *Alladin Oil Burner* v. *Morton*, 117 N. J. Law 260, 187 Atl. 350 (1936); *Center* v. *Kelton*, 20 Cal. App. 611, 129 Pac. 960 (1912); *Givens* v. *Johnson*, 73 Cal. App. 2d 139, 166 P. 2d 67 (1945).

** *Crescent Oil Co.* v. *Brumley*, 169 Okl. 462, 37 P. 2d 593 (1934); *Hawkins* v. *City of St. Joseph*, 281 S. W. 420 (Mo. 1926).

bia in *Tri-State Broadcasting Co.* v. *Federal C. Comm.*, 107 F. 2d 957, summarized the value of oral argument in these words:

> "It might very well induce the Commission to make one finding, when without such argument, it may have made a contrary finding. Right of argument is an indispensable step to a fair hearing."

This Court has shown acute awareness of the value of oral argument. In the *WJR* case, *supra*, while disagreeing with the Seventh Circuit Court of Appeals because of the circumstances of that case, this Court stated,

> "Without in any sense discounting the value of oral argument wherever it may be appropriate, or by virtue of the particular circumstances, constitutionally required, * * *" idem 276

If oral argument before the Master had been permitted, petitioner would have been able forcefully to marshal and present the facts from this voluminous record of technical data, point out their relative importance, and assist the Master by a Socratic exchange. Aided by oral argument the Master would never have been confronted with the task described by the District Court as a "search through hundreds of pages of laboratory records" and "digesting of literally thousands of pages of documentary evidence", 121 F. Supp. 494.

Petitioner, without fault on its part, has been unfairly deprived of its right to make an oral argument after that right had been promised by the Master. Relying on that promise petitioner's briefs before the Master were written and submitted in contemplation of the fulfillment of that promise by the Master. To overlook that promise in a

case abounding in complex issues of both law and fact constitutes a denial to petitioner of an indispensable element of "rudimentary judicial fair play" and hence a denial of due process. Had oral argument been permitted before the Master's views had become crystallized in the form of his Report, contrary findings would probably have been made and the questions presented herein would probably not have arisen.

In view of the increasing number of references to special masters by the already overworked District Courts, the sufficiency of the procedure involved in the case at bar should be determined by this Court so as to aid in the administration of justice in the many cases arising in this field of judicial procedure.

Question 2. Does the direct conflict between the Second Circuit holding below that the patent in suit is invalid and the holding of validity by the District Court for the District of Columbia which ordered the U. S. Patent Office to issue the patent create such uncertainty in Patent Office administration and such confusion in a $100,000,000 a year industry as to require settlement by this Court?

In a suit against the Commissioner of Patents in the District of Columbia under R.S. 4915 (hereinafter referred to as the 4915 case) Judge F. Dickinson Letts, at the end of a long and thorough trial involving testimony of expert witnesses on behalf of both petitioner and the Commissioner of Patents, rendered the following opinion from the bench:

> "The Court concludes that invention has been shown. The Court rules that a new result has been achieved, and that these claims, as far as the Court can see, are in proper form to cover the invention. The Court will authorize the Commissioner of Patents

to issue the claims and will ask Mr. Finnegan to present for settlement findings of fact and conclusions of law and a judgment form consistent with this pronouncement." (PX 78)

The findings of fact and conclusions of law entered subsequent to that opinion are set forth at D.A. E1581-E1594. With one exception (Canadian Speakman patent No. 365,290, not before him and which is discussed under Question 3, *infra*), the prior art patents and publications ruled upon adversely to petitioner by the courts below were found by Judge Letts not to anticipate or invalidate the invention. The courts below denied the existence of invention; Judge Letts concluded that "invention has been shown".

The most material point of cleavage between the two decisions, however, is in the criteria applied by the two courts for determining the question of invention. The Court of Appeals in the instant cases (as well as the District Court and the Special Master) disregarded the *results* or performance achievements of the invention versus the prior art and based its rulings essentially on the requirement that, regardless of results, sharply critical physical or chemical phenomena must delineate the invention. This viewpoint is based upon a warped and truncated extract from the language of *Kwik Set, Inc.* v. *Welch Grape Juice Co.*, 85 F. 2d 945, discussed specifically under Question 4, *infra*. Judge Letts, on the other hand, evaluated the invention in terms of the result achieved, following the view of this Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U. S. 271, 27 (1949), where it was held that the difference between the invention and the prior art "is best manifested by the performance achievements of the invention" (D.A. E1593).

Following the proper criterion of *Graver* v. *Linde* instead of the artificial Second Circuit rule mistakenly derived from the *Kwik Set* case, Judge Letts appreciated and found the new results which support the holding of invention. For example, he found:

"10. Prior to the filing of McDonough's application there was a long-felt commercial need for a safe, efficient and comfortable cold permanent waving solution. Prior commercial solutions of sulfite compounds were very slow-acting; while commercial solutions of hydrogen sulfide compounds were mal-odorous and poisonous.

"12. The disclosure and teachings of the McDonough application in suit are based on research, including synthesis and testing of rare mercaptan compounds, conducted over a number of years prior to the filing of said application.

"13. McDonough's mercaptan waving solutions have enjoyed great and progressive commercial use, supplanting all prior commercial cold permanent waving solutions and largely displacing the prior commercial forms of hot permanent waving. Because inherently safe and because the waving speeds thereof can be so accurately controlled, a new industry of home permanent waving has been based upon the teachings of McDonough's application.

• • •

"29. The subject matter disclosed in the McDonough application and defined in the claims in issue achieves new and unexpected results in the art of permanent waving and clearly involves invention.

"30. The compositions and the methods defined in the claims in issue are the result of inventive genius

far beyond the skill of the routine chemist in the permanent waving art." (D.A. E1584-5, E1592)

The opinion of the Court of Appeals (as well as that of the Special Master and the District Court) wholly lack any reference to or discussion of the *results* of the McDonough invention. In spite of the evidence, there is no appreciation of the remarkable performance achievements whereby the invention made cold permanent waving a practical and useful art, eventually supplanting entirely all prior methods and compositions. Instead, as discussed under Question 4 *infra*, the Court of Appeals considered the invention in the sterile and highly academic atmosphere of "criticality," disregarding the fact that a new composition of matter was disclosed which produced new and outstanding results. The Courts below applied the rigid chemical rule of the truncated *Kwik Set* decision as though the claimed invention were merely a change in proportions of the ingredients of an old composition of matter. Moreover the Courts below treated the invention as though it were some mathematically precise instrument whose requisite characteristics were precipitous sharpness of function at precisely defined borders, rather than a composition of matter applicable to living human hair where all the variations of biochemistry are present.

The artificially precise viewpoint of the Court of Appeals also led it to err in evaluating the prior art on the question of invention. The *results* of the compositions of the prior art were wholly ignored and no comparison was made between those results and the result of the invention claimed.

While the conflict in decisions here referred to is not the classic case of conflict between two Circuit Courts of Appeal upon the same patent, the damage and confusion resulting from it is even more serious. Judge Letts' de-

cision is binding upon the Patent Office and the rules of law and the holdings with respect to the invention of the subject matter involved govern the actions of that administrative arm of the government.

The conflict also extends to petitioner's licensees Procter & Gamble, Lever Bros., etc., who are entitled to cancel their licenses upon a final holding of invalidity but are put into a quandary by the conflicting holdings now outstanding. The conflict in decisions here presented calls for review by this Court so that the tremendously large, nationwide industry involved and the administration of the Patent Office on patents in that field may proceed under uniform holdings.

Question 3. Is a Canadian patent, typewritten but not printed, disclosing subject matter in its specification which is not claimed in the patent, an anticipation of a United States patent within the meaning of 35 U. S. C. 102 (b)?

35 U. S. C. 102(b) provides in pertinent part as follows:

> "A person shall be entitled to a patent unless * * * the invention was *patented* or described in a *printed* publication in this or a foreign country * * * more than one year prior to the date of the application for patent in the United States."

The Court of Appeals held that *unclaimed* subject matter in the specifications of an unprinted Canadian patent was applicable prior art and invalidated the United States patent in suit pursuant to the provisions of 35 U. S. C. 102(b) (p. 14a). Petitioner contended in the Court of Appeals both on the submission of the appeal and in its petition for rehearing that the unclaimed subject

matter in this typewritten Canadian patent was neither "patented" nor a "printed publication" within the meaning of 35 U. S. C. 102(b). This contention of petitioner was summarily dismissed by the Court of Appeals as "untenable" (p. 14a).

If the language of the Court of Appeals means that the unclaimed subject matter appearing only in the specification of the Canadian patent is "patented" within the meaning of that term as used in 35 U. S. C. 102(b), the rule of law so announced is in conflict with the interpretation of "patented" made by that same Court in *General Electric Co.* v. *Alexander*, 280 F. 852 (1922). That same Court held:

> "It is not sufficient that the foreign patent may disclose the invention of the later U.S. patent where it is not therein claimed." *idem* 854.

Furthermore, the present pronouncement of the Court of Appeals is in conflict with the interpretation of "patented" as used in 35 U. S. C. 102(b) rendered by the Court of Appeals for the Sixth Circuit in *Permutit* v. *Wadham*, 15 F. 2d 20, 21 (1926). In the *Permutit* case the Court held, in referring to a typewritten German patent "* * * nothing is patented except what is claimed."

That there is a conflict in the decisions is recognized by the Court of Appeals of the Seventh Circuit in *Permutit Co.* v. *Graver Corporation*, 43 F. 2d 898 (1930), where that Court said at page 902:

> "* * * As the printed publication is restricted to the claims of the Gebrauchmuster, it seems extremely doubtful whether Gans' right to a patent in the United States could be barred by the disclosures in the specifications of the Gebrauchmuster.

"The weight of authority seems to exclude use of the entire Gebrauchmuster as anticipation. But the Courts are divided on the question. Permutit v. Wadham (C.C.A.) 13 F. 2d 454; American Chain Co. v. Bethlehem Bumper Corp. (D.C.) 25 F. 2d 759; Acme Acetylene Co. v. Commercial Acetylene Co. (C.C.A.) 192 F. 321; Permutit v. Paige & Jones Chemical Co. (C.C.A.) 22 F. 2d 916; Safety Gas Lighter Co. v. Fisher Bros. & Corwin D.C. 236 F. 955; Steiner v. Schwartz (C.C.) 148 F. 868, 870; Fireball Gas Co. v. Commercial Acetylene Co. 239 U.S. 156; Leeds and Catlin v. Victor 213 U.S. 301, 309; General Electric Co. v. Alexander 280 F. 852."

The holding of the Court of Appeals in the case *sub judice* is also in conflict with the interpretation of the word "patented" as used in R.S. 4887 wherein this Court held in *Leeds and Catlin* v. *Victor Talking Machine Co.*, 213 U. S. 301 (1909), that "patented" means effectively monopolized or claimed in a foreign country. The language of R.S. 4887 and 4886 (the latter statute being the one from which 35 U. S. C. 102(b) is derived) is the same in this particular and both refer to the effect of a foreign patent. Hence the interpretation "patented" in R.S. 4887 would apply with equal force to R.S. 4886 or 35 U. S. C. 102(b).

Under Canadian law the specifications of a patent are no part of the Canadian monopoly. Only that which is claimed is "patented" in Canada. *Revised Statutes of Canada*, Chap. 203, Sec. 36(2), is as follows:

"The specification shall end with a claim or claims stating distinctly and in explicit terms the things or combinations that the applicant regards as new and in which he claims an exclusive property or privilege."

See also *Fox* "Canadian Patent Law and Practice", pp. 389-396 (3rd Ed. 1948).

The Court of Appeals held that the Canadian patent "disclosed in its *specifications* the use of" the alleged anticipating subject matter (p. 14a). It is therefore clear that the subject matter alleged to anticipate was disclosed only in the typewritten specifications (D.A. E157-E173) of the Canadian Speakman patent.

These conflicting holdings of the Second and Sixth Circuit Courts of Appeal with respect to the proper interpretation of the word "patented" as used in 35 U. S. C. 102(b) should be disposed of by an authoritative pronouncement by this Court in order that there may be uniformity within the Courts below as to the proper effect to be given foreign patents when urged as anticipations of U. S. patents. The Court of Appeals for the Sixth Circuit justified its holding that only what is claimed is "patented" by following the reasoning of this Court in the *Leeds and Catlin* case, *supra*. It is submitted that the holding of the Sixth Circuit Court is correct and correctly interprets the intent of Congress when 35 U. S. C. 102(b) was enacted.

If the language of the Court of Appeals in the case *sub judice* means that the language "printed publication" in 35 U. S. C. 102(b) permits a typewritten document to constitute a bar under the above section of the code, such a rule of law is in conflict with the plain language of the statute itself. When the term "printed" is used it is used in other sections of the patent law in contradistinction to "typewritten". The fact that Congress recognized that the two words mean different things is manifest from 35 U. S. C. 22 wherein Congress authorized the Commissioner of Patents to require that papers filed in the Patent Office must be either "printed or typewritten". It is inconceiv-

able that by using "printed" and "typewritten" in Section 22 in this manner Congress intended that "printed" also meant "typewritten" in 35 U. S. C. 102(b). This leads to the inescapable conclusion that only description in a "printed publication" was considered by Congress sufficient to constitute a bar. A typewritten document is insufficient.

A definitive and proper interpretation of 35 U. S. C. 102 (b) in this respect is of vital importance to the administration of the Patent Office and of the patent laws by the Courts.

To support its ruling the Court of Appeals cited *Sirocco* v. *Sturtevant*, 220 F. 137, and suggested comparing *Trico* v. *Delman Corp.*, 180 F. 2d 529 (C. C. A. 8). In the *Sirocco* case a French patent was involved. The question here presented did not arise in the *Sirocco* case. No distinction was made between what the French patent disclosed and what was "patented" therein and the facts as reported in that decision cast no light upon the question here arising under Section 102(b). Moreover, in France everything that is contained within the four corners of the patent documents constitutes the monopoly conferred in that country. Unlike Canada, France does not restrict the monopoly to that which is claimed. The *Sirocco* case clearly does not sustain the conclusion of the Court of Appeals that disclosures appearing only in the typewritten specifications of a Canadian patent are "patented" within the meaning of that term in 35 U. S. C. 102(b).

The *Trico* case is concerned with the effective *date* of an Italian patent and is not concerned with what is "patented" within the meaning of that term in Section 102(b).

The holding of the Court of Appeals as it relates to either the meaning of "patented" in Section 102(b) or the meaning of "printed publication" in said section is plainly

in error and calls for this Court to exercise its discretion on petition for a writ of certiorari. Only in this way may this Court resolve the conflicting decisions and guide the Patent Office and the lower Courts with respect to a proper interpretation of 35 U. S. C. 102(b).

Question 4. Regardless of prior art teachings, or lack thereof, must a biochemical invention consisting of a new composition of matter nevertheless be bound by precipitous limits, beyond which no results of the invention can be obtained, in order to be patentable as the Second Circuit held below; or, in accordance with the Sixth Circuit rule and the *Expanded Metal* and *Mineral Separation* decisions of this Court, is such biochemical composition patentable if it displays inventive results over the prior art?

A basic error of important law infected the entire proceedings below. Its effect, if uncorrected, casts a great blight over all chemical patents litigated in the Second Circuit.

The patent in suit is for a new composition of matter, consisting of substituted mercaptans and weak alkaline agents in solution. The patent specification teaches that if the pH is too high the hair will be "destroyed or badly damaged" (D.A. 2971) and, further, "the use of pHs above 9.5 must be watched very carefully for with pH 10 or above, hair destruction or injury *may* occur before a satisfactory wave is obtained" (D.A. 2971).

The only prior art reference disclosing a mercaptan for any kind of waving was Speakman (D.A. 2965). Although Speakman disclosed only a mercaptan in combination with a *strong* alkaline agent, the Master held McDonough was not the first to discover mercaptans for waving and: "defendant posits invention * * * on the discovery that special laws and criteria govern mercaptans in hair waving" (D.A. 2965).

Defendant's contention was summarized by the Master as: "In so far as pH is concerned, the crux of McDonough's invention lies in the discovery that mercaptans can and must be used, *for sure and safe results,* at pH values below 9.5" (D.A. 2965).

The Master then set forth what he considered the applicable law of "criticality"—the discovery of a "*point* at which some result differing in kind—and not merely in degree—from the results achieved by the prior art" (D.A. 2966).

But, he said this rule was settled "at least for this Circuit" by the following statement (D.A. 2966-7) written by Judge Manton in *Kwik Set Inc.* v. *Welch Grape Juice Co.,* 86 F. 2d 945, 947 (C.A. 2, 1936):

> "A patentee may not arbitrarily select a point in a progressive change and maintain a patent monopoly for all operations in that progressive change falling on one particular side of that arbitrarily selected point. It is only where the selected point corresponds with the physical phenomenon and the patentee has discovered the point at which that physical phenomenon occurs that the maintenance of a patent monopoly is admissible."

This truncated Second Circuit statement on "criticality" mentions nothing concerning a comparison of the patent results with the prior art results, and it utterly demolished petitioner's patent before the Master who felt bound by the rule. It has hung around the case like an albatross ever since.

For the Master than brushed aside the truthful statements of the patent and defendant's contention that for "sure and safe" results pH should be 9.5 or below because of the "race" between waving and damage. It did not

matter that no art had discovered or taught the relationship between speed of waving and speed of damage. Without the advantage of oral argument the Master felt forced by the *Kwik Set* statement to accept the plaintiffs' contention that "criticality" in the instant case simply meant "waving versus no waving" (D.A. 2977-8) disregarding the great tangible achievements in solving the problem of providing rapid-acting, non-toxic, flexible cold waving compositions.

As day follows night the Master then looked to the evidence and found it was *possible* to get a satisfactory wave *with McDonough's compositions* above McDonough's limits of pH 9.5 and 10 under certain controlled conditions, a fact almost expressly stated in the patent itself. McDonough and his expert, Snell, so testified. Because any kind of wave at all could be obtained without damage above 9.5 and 10, the Master concluded:

> "permanent waving beyond McDonough's 'critical' limits differs only in degree from waving within those limits. (D.A. 2983)
>
> * * *
>
> "This is not to say that there may not exist some pH point above which permanent waving is impossible, nor is it to say that pH 9.5 might not constitute some convenient boundary line for commercial waving operations. (D.A. 2983)
>
> * * *
>
> "these tests contradict any notion of patentable criticality." (D.A. 2981)

The Court of Appeals affirmed the *Kwik Set* rule as applied by the Master *in haec verba* (p. 5a). Defendant's assertion that McDonough's composition provided results

differing in kind over the actual results of the prior art was dismissed as argument of mere "commercial superiority". It too held McDonough's pH 10 was an "arbitrary" point selected in a range of progressive change, because occasional loose waves could be obtained above that limit with McDonough's composition (148 F. 2d 154). Under this holding there could be no criticality invention no matter what were the results of the prior art. These rulings below were in violation of two fundamental principles long ago stated by this Court.

In *Expanded Metal* v. *Bradford*, 214 U. S. 366, 381 (1909) this Court condemned in strong language the invalidating of patents by theoretical dissection of the invention into its individual elements to find non-invention of the whole through anticipation of the separate parts. The Court stated that the new conjunction of old elements may be patentable if it accomplishes *new results* in a particular environment presenting peculiar and different problems.*

The rule controlling "criticality" inventions was set forth in *Minerals Separation* v. *Hyde*, 242 U. S. 261 (1916). There the lower courts were admonished not to confuse breadth of invention with structural change—because great invention might exist though it appear to be only a minor or slight variation over the prior art as to structure or formula. This was based on the fact that "invention" is an elusive legal concept and cannot be measured by scale or yardstick like coal and rope. In that case the minor

* The continuing vitality of this rule was expressed in *Great A. & P.* v. *Supermarket*, 340 U. S. 147 as: "when the whole exceeds the sum of its parts is the accumulation of old devices patentable." In striking down the mechanical combination there before it, the Court stated: "Two and two have been added together, and they still make only four" but particularly noted: "Elements may, of course, *especially in chemistry or electronics*, take on some new quality or function from being brought into concert."

change of oil concentration in an ore flotation process from the prior art 6% to "a fraction of one percent" was held to be great invention. The low concentration of oil in the patent was called "critical" by this Court because it provided results differing in kind from the results with the prior art 6% oil.

But the Second Circuit rule below, grafts a new and erroneous additional requirement upon the salutary "criticality" rule of this Court. In the Second Circuit no cognizance is taken of the results of actual prior art compositions. The "peculiar and difficult" problems or the "environment" of waving à la the *Expanded Metal* case are ignored. It matters not that two plus two has been made to equal five. Even though waving compositions are used on the human heads of millions of women under many differing conditions of care and skill with dangers reaching even to death, and the invention here provided the first safe cold wave, these are mere facets of "commercial superiority" according to the Second Circuit and have no bearing on invention. Under the Second Circuit law it is not enough that the new results differ in kind from the prior art results as in *Minerals Separation*. Such comparison is not even relevant.

The only matter of importance in the Second Circuit is that the results *of the new invention* must themselves be bound by an inexorable limit at a sharp point. Unless a chemical invention is limited within itself by a chemical phenomenon which exists as sharply as the boiling point of water, there is no invention. McDonough is not compared against the prior art, but against himself.

The flotation process of *Minerals Separation* is a conspicuous example of a chemical invention with fuzzy edges. There the desirable results of the patented composition tapered off slowly as the percentage of oil was in-

creased to 6%. The Second Circuit rule however denies patents on these results, regardless of inventive genius.

The rule of *Kwik Set* as applied below has its origin in Judge Manton's opinion in *Claude Neon* v. *E. Machlett*, 27 F. 2d 702 (C.A. 2, 1928). There is a direct conflict with the Sixth Circuit.* In *Sun Ray* v. *Claude Neon*, 49 F. 2d 886, 889, 890, Judge Hickenlooper stated:

> "Finally it is claimed that at the indicated pressure of say, 2 mm., the ratio of 1.5 square decimeters of electrode surface area per ampere of current, stated in the claim, is arbitrary and meaningless, and, since it was this pressure of not to exceed 2mm. which Claude had in mind, the indicated ratio did not represent *a 'critical point', above which all was good and below which all was bad*, and this invalidated the claim. We do not deem it necessary, in order to uphold the claim, that the stated ratio designate a critical area, as was found by Judge Manton in the first Machlett case (C.C.A.) 27 F. (2d) 702, 706. It seems to us that an applicant for a patent may be partly arbitrary in the selection of a limitation above which he claims and below which he abandons his invention to the public. Minerals Separations, Ltd. v. Hyde, 242 U.S. 261, 37 S. Ct. 82, 61 L.Ed. 286, is expressly in point. Doubtless the Patent Office requires such limitation in many cases, while in others a greater indefiniteness has been allowed. See Mowry v. Whitney, 14 Wall. 620, 644, 20 L.Ed. 860; Tilghman v. Proctor, 102 U.S. 707, 729, 26 L. Ed. 279; Carnegie Steel Co. v. Cambria Iron Co., 185 U.S. 403, 436, 22 S. Ct. 698, 46 L.Ed. 968; Eibel

* In *Dow* v. *Halliburton*, 324 U. S. 320 (1944), this Court cited the *Kwik Set* case generally as a recent example of the "progressive change over *the prior art*" rule. But the *Kwik Set* statement considered controlling below was not pertinent to the *Dow* case where this Court actually compared the results of the invention with the results of the prior art.

Co. v. Paper Co., 261 U.S. 45, 66, 43 S. Ct. 322, 67 L.Ed. 523; and other cases already cited. *The rule* upon which the appellant relies *forbids only such limitations as are wholly arbitrary,* that is, *which in no true sense describe or define the nature of the invention and its departure from the prior art.* Such is not the case here. The ratio of 1.5 is descriptive of a vastly increased surface area of the electrodes *over those used in the spectral tubes of the prior art, the only tubes theretofore employing a content of neon.* At some pressures the ratio does indicate a 'critical point'. At all pressures it is indicative of an important element of the invention." (Emphasis supplied.)

The Second Circuit rule is particularly inappropriate in the instant case. The invention is primarily biological in nature. Living organisms and their products abide by no mathematical rules of split precision. Nature moves in pleasant curves, not in abrupt right angles. There is not a biologist or a physician in the nation who would expect any substance to react with precise uniformity on human hair. The Master himself stated:

"Human hair, I think * * * is not quite so uniform a structure as gases or liquids or solutions maintained in the laboratory test tube conditions.

* * *

"And * * * there is therefore a factor of idiosyncrasy and variability, age, etc., etc., etc., * * *". (D.A. 1023)

So far as we know, this Court has not had opportunity for 75 years to pass on the requisites of invention in materials directly reacting on the human body. The last case was *Seabury & Johnson* v. *Am Ende,* 14 S. Ct. 683, (1894) which dealt with antiseptic dressings applicable to wounds.

There this Court showed grave concern with the peculiar and difficult problems associated with such inventions, and emphasized the importance of medical discovery to the progress of the science and useful arts.

If the decision below be left to control in the Second Circuit and set a precedent that may be followed in Circuits other than the Sixth, there is bound to be great mischief working enormous hardships on many inventors and patentees. A very large percentage of patent cases occurs in the Second Circuit.

With the advent of miracle drugs and the widespread acceleration of research on human biochemistry in the pharmaceutical, cosmetic and therapeutic industries, it is particularly vital that the law of criticality invention be settled by this Court as to these important fields.

Question 5. Can genus claims be invalidated by use or knowledge of a species by another prior to completion of the invention of the genus but after the invention of the same species by the patentee?

The generic claims of the patent in suit were held anticipated by the prior experimental uses of mercaptan solutions by Grant and Martin (p. 20a). These uses took place in the period November 1940-March 1941, all less than one year before the filing date of the patent in suit (D.A. 3022-3). The Grant and Martin uses were of compositions embodying a single species of McDonough's generic claims, *i.e.* compositions of one mercaptan, thioglycolic acid.

The undisputed facts of record show that by 1937 McDonough had invented and tested the same thioglycolic acid species and the Court of Appeals recognized these facts (p. 12a). This species invention by McDonough was long before any knowledge or use of such species by the others. In recognition of that fact situation the Patent

Office granted patent No. 2,736,323 on February 28, 1956 to McDonough on the thioglycolic acid species after interference with Martin and award of priority.

Thus McDonough is the prior inventor of the species as well as inventor of the genus claimed in the patent in suit. Also McDonough's research in the period 1935-1941 on the waving effects of various species led to his discovery of the criteria governing the hair-waving action of the genus or class—the objective he set for himself in 1935 (D.P.X. 8, D.A. E1529). He was the first to invent the species and also the inventor of the genus. McDonough had more than equalled the efforts of Grant and Martin long before they entered the field.

Thus Grant and Martin are not *prior* users or *prior* inventors under Section 102(a) or (g). Their activities merely repeated what McDonough had already accomplished. The fact that they intervened in time before McDonough had completed invention of the genus should not deprive McDonough of the priority effect of his work on the very same species.

To permit the ruling of the Second Circuit to stand would perpetuate a rule contrary to the long-established practice of the Patent Office. Research leading to inventions generic to a class of chemicals customarily proceeds from discoveries as to individual members of the class from which the generic discoveries are derived. To hold that the generic invention is anticipated by a belated use of a species when that same species had already been invented by the inventor of the genus is to hold that water can rise above its source. It is a holding that penalizes inventors who conduct research on several species in order to discover the generic features of a chemical class rather than rushing into the Patent Office when only a specific discovery has been made.

The Patent Office rule is stated in a well considered article in the Journal of the Patent Office Society, 21 J. P. O. S. 664, 666: "If it is possible to prove a prior reduction to practice of the very species disclosed in the reference, that should completely dispose of the reference." This rule is exemplified in numerous decisions by the Board of Appeals of the Patent Office, *e.g. Ex parte Clifford,* 30 USPQ 232; *Ex parte Sebrell,* 36 USPQ 80; *Ex parte Clark,* 60 USPQ 72; *Ex parte Fryling,* 75 USPQ 9; *Ex parte Burt,* 86 USPQ 186, 188. The decision *In re Steenbock,* 83 F. 2d 912 (C. C. P. A. 1936) relied on below (p. 3a) is distinguished because there the intervening reference was *a statutory bar* under 35 U. S. C. 102(b), being published more than two years before the application for the genus invention. *Cf. In re Kaase et al.,* 60 USPQ 565, 567 (C. C. P. A. 1944), 140 F. 2d 1016, 1019. The Grant and Martin uses took place less than one year before McDonough's application was filed (D.A. 3022-3).

We have found no decision of the Federal Courts passing on this question in patent infringement litigation. However it is clear that, under the terms of Section 102(a), the subject matter *known* or *used* by Grant or Martin was not known or used by them "before the invention thereof by (McDonough) the applicant for patent." In view of its importance in the prosecution and evaluation of chemical patents we respectfully submit that this question should be ruled on by this Court.

Question 6. Can there be double patenting between the claims of a patent limited to hair waving without damage over the claims of a depilatory patent limited to hair destruction?

The Court of Appeals held that petitioner was between the horns of a supposed dilemma because of the "acute and accurate reasoning" of the Master on the point of double patenting. (See footnote, p. 19a. which was injected by him into the case in spite of the fact that "plaintiffs do not press this point vigorously.")

The Master overlooked the rule of law that limitations of the claims in suit, which he called "functional," would restrict the scope and preclude infringement thereof by a depilatory composition regardless of how identical were the ingredients. Mr. Justice Brown put the point succinctly in *McClain* v. *Ortmayer*, 141 U. S. 419:

> "If the language of the specification and claim shows clearly what he desired to secure as a monopoly, nothing can be held to be an infringement which does not fall within the terms the patentee has himself chosen to express his invention."

See also *Palmer* v. *DeYough*, 90 Fed. 281 (S. D. N. Y.), and *Electro-Dynamic* v. *U. S. Lighting*, 278 Fed. 80 (C. A. 2, 1921).

This is manifest from a comparison of the radically different limitations which appear in the claims of the depilatory and permanent waving patents, respectively:

Claim 6 of Depilatory Patent No. 2,352,524 (D.A.E. 152)	**Claim 2 of Patent in Suit, No. 2,577,710**
A *depilatory* for use in *removing human hair* from the body * * *	A *permanent waving composition* * * *
the amount of mercaptan being *sufficient to render the hair removable* after contact therewith *within a short time* and without irritation to the skin * * *	the concentration of mercaptan and the pH of the solution being adjusted * * * to obtain a *permanent change in the configuration of human hair* during a given time of application at temperatures tolerable to the human body *without damage to the hair structure.*

These typical limitations of the patents are binding on the patentee as a matter of claim scope. They define the type of composition which can be infringed. They limit the relations of pH and concentration within those compositions. They confine any enforcement of the patent in suit to *permanent waving compositions* capable of completing a permanent wave *without damage to the hair structure.* It matters not that a *misuse* of the hair waving solution (by leaving it on the hair too long after the wave was completed) might injure the hair. Depilation is repugnant to waving without damage; a person destroying hair is using no teaching of the waving invention, but the opposite. Any person skilled in the art would so read the patent in suit. No court could hold that claims on a waving composition limited to preserving hair unharmed until waved was

the same patent monopoly as that recited by claims on a depilatory composition designed, adjusted and used to destroy hair structure so that it was severed and removable from the body. It is inconceivable that the monopolies of these patents be identical. It is the same as holding that a razor blade would infringe a patent on a hair comb or curler.

Absent a real overlap in the monopolies secured there can be no double patenting. *Miller* v. *Eagle*, 151 U. S. 186 (1894).

There being in fact no double patenting, the "dilemma" which troubled the Court of Appeals does not exist. Hence the failure of the Court of Appeals to affirm the lower court in holding that the entity "Evans and McDonough" is not "another" than McDonough under §102(e) is error. If the lower court be right, there can be no anticipation of the patent in suit by the same inventor in an earlier, copending application.

If, on the other hand, the entity "Evans and McDonough" be regarded as "another," the patent in suit is none the less valid under the doctrine discussed under Question 5, *supra*. The record is clear that McDonough had completed far more of his permanent waving invention than may be disclosed in the depilatory patent, long before the filing date thereof (D.A. E1203, 1524, 1525). In so far as common subject matter exists, claimed as McDonough's invention in the patent in suit, he is entitled to the priority of the filing date of the depilatory patent thereon.

Question 7. Must an inventor who abandons or dedicates part of his invention be more precise than an inventor who claims his invention to the hilt?

The four claims on appeal, 2, 12, 17 and 18, are all drawn to a mercaptan concentration of 10% or less and to a pH of 9.5 or less, as contrasted to the broader teachings of the patent specification which warn the art to keep the concentration of the invention less than 15% and the pH less than 10.0.

For this reason the Court of Appeals below held that words of some degree of approximation could not be tolerated in those claims, and that each of the claims was fatally indefinite because they contained the expression "about"*. The Court stated:

> "the applicant if he wished was entitled to claim a monopoly narrower in scope than that of his full disclosure and thereby abandon to the public so much of his invention as lay outside his stated claims * * * However, because this was done the requirement of the Act must be strictly construed. In the ordinary case, in which the intended scope of the claims is commensurate with the scope of the disclosure, any peripheral uncertainty as to the claims can be clarified by reference to the application. Not so, however, when the claims are concededly narrower than the disclosure, as here. Confronted with claims such as these, a member of the public is left at his peril to guess just where the applicant has drawn the line between his claimed monopoly and the public domain. * * *
>
> "We do not, of course, go so far as to hold generally that claims defining range limitations with some degree of approximation are in all cases fatally in-

* Claims 2 and 12: about 8%, about 6%, about 9.2; Claim 17: about 1%, about 10%, about 9.2; Claim 18: about 6%.

> definite. Our holding here relates to limitations on claims which are narrower than the invention disclosed in the specifications and which purport to assert a private monopoly of compositions falling within a known chemical genus." (p. 20a-21a)

This is a broad and sweeping pronouncement that is contrary to public policy, it is certain to create enormous mischief to patentee litigants in the Second Circuit and in the Patent Office, and requires exercise of corrective jurisdiction by this Court.

Use of the word "about" and similar words in patent claims has been accepted patent practice for generations*. The word is a mere attempt to avoid in advance what this Court recognized and prevented after the fact in *Graver* v. *Linde*, 339 U. S. 605, 607-9 (1950):

> "One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of piracy. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. * * *
>
> "a patentee may invoke this doctrine [equivalents] to proceed against the producer of a device 'if it performs substantially the same way to obtain the same result.'" **

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* *Ex parte King*, 82 USPQ 450 (1948) and see cases cited therein.

** See also the almost identical statement of Judge Learned Hand holding the word "substantially" definite in *Musher Foundation* v. *Alba*, 150 F. 2d 885 (C.A. 2) at page 889 citing *Eibel Process* v. *Minnesota Paper*, 261 U. S. 45, 65.

But the Court of Appeals below held that because Dr. McDonough dedicated part of his invention to the public, he could no longer use the word "about"! Obviously such a rule will not imbue inventors with public spirit, and certainly will not foster advance of the science or arts.

The reason cited by the Court of Appeals—that the public is left at its peril to determine the meaning of "about"—is erroneous. The breadth of approximation inherent in "about" is the same whether it qualifies "pH 9.2" or "pH 10". In each instance it defines the boundary of the claimed invention as to substance and merely forecloses infringers who vary the invention solely as to form. As Judge Learned Hand stated in *Musher Foundation* v. *Alba, supra*:

> "It is impossible to suppose that anyone who really wished to respect the patent would have any difficulty in identifying what the claimed covered."

Indeed the Master had no difficulty in determining reasonable bounds for claims 2, 12, 17 and 18 in holding them infringed by all respondents below (D.A. 3049-3051), a fact never considered by the Court of Appeals.

If the rule of the Appellate Court be permitted to stand, all patent litigants in the Second Circuit who have not claimed their inventions to the hilt will be struck down by a retroactive principle devoid of logic and unfounded in law. The public will be the victim through curtailment of patent dedications.

Question 8. Can the Court of Appeals ignore the provisions of 35 USC 135 and 37 Code of Federal Regulations 1.201 (a) and (b) which bound the Patent Office Examiner in his conduct to make a finding that the patent application contained patentable subject matter before declaring an interference and hold that there was no evidence that the Patent Office had made such a determination when the undisputed evidence established that the Examiner did in fact declare an interference?

Question 9. Did the lower Courts perform their proper judicial functions:

(a) When the Courts found no causation based on the false premise that the Patent Office had neither formally allowed the patent application nor indicated that it was formally allowable in the face of undisputed evidence that (1) Respondent Helene Curtis admitted that the application contained allowable claims, (2) Patent Office Examiner's written record showed the application contained allowable claims, (3) the testimony of an expert in Patent Office procedure and practice interpreting the language of the established Patent Office Action that the application contained allowable claims?

(b) When the Court ignored undisputed evidence that the protest contained misrepresentations of fact and held that no misrepresentations were shown?

(c) Where the lower court ignored the law as to the standard of conduct required by parties appearing before the Patent Office and held that a little false swearing is to be expected?

The Facts

The application for the patent in suit was filed June 16, 1941. After a Patent Office action in June, 1946, rejecting all claims of the application on various grounds (D.A. 7B-11B) the petitioner submitted an amendment striking all previous claims and adding claims 68 to 88, both inclusive, accompanied by voluminous affidavits and arguments directed to overcoming the grounds of the Patent Office examiner's rejection of June, 1946 (P.X. 2, Paper #16, pp. 182-295; D.A. E1105-10). In December, 1946, the Patent Office notified petitioner of the Patent Office intention to declare an interference between the application for the patent in suit and the application of Martin (D.A. 14B). In February, 1947, the Patent Office formally notified petitioner of the declaration of interference between Martin's application and the application for the patent in suit pursuant to 37CFR 1.201 (a) and (b) (D.A. 15B). Claim 88 of the petitioner's application was the sole count in the interference (D.A. 15B). Pursuant to Patent Office practice there followed the so-called motion period (D.A. 15B, 33B, "Interference Law and Practice"—Rivise & Caesar, Vol. II, par. 213, p. 863). Both parties to the interference, pursuant to regular practice, made motions to dissolve the interference on various grounds (D.A. 33B, 23B). These motions were denied by the Patent Office Examiner who stated in an official action addressed to petitioner, dated December 1947, that "since there is undoubtedly a common invention involved the Examiner hereby suggests a new count as follows:" (D.A. E548, E544, 35B). Petitioner then objected to the suggestion of the new count in interference by the Examiner maintaining that the Examiner had exceeded his jurisdiction (D.A. 41B, 50B, 69B).

In March 1948, Martin, having the interference file of the application for the patent in suit in his possession (D.A. 501, 518, 707), approached Samuel Grant and Maurice Cayne, the Director of Research and patent counsel, respectively, of the respondent Helene Curtis (D.A. 273, 501) for the purpose of selling Martin's application to Helene Curtis (D.A. 272-274). Grant and Cayne thus obtained complete information as to the action of the Patent Office in holding claims 68 to 88 of petitioner's application as being allowable claims (D.A. 276). After acquiring this information, Grant ran some experiments (D.A. 707-709) and together with Cayne drafted an *ex parte* protest to be submitted to the Patent Office protesting the issuance of a patent to petitioner on the subject matter contained in claims 68 to 88 (D.A. E661-694).

This protest contained misrepresentations of fact established by the undisputed evidence (D.A. E696, D.X. 232; D.A. 695-96, E696; D.A. 698, D.X. 233, E697; D.A. E691; D.A. 655, 713, 715, D.A. E690-91, D.A. 512; D.A. E438, D.A. 662, 717, 533) and not considered by either the Master (D.A. 3055-3056) or the District Court (D.A. 3255) or the Court of Appeals. The thrust of the protest was directed to the destruction of the affidavits filed by petitioner in September 1946 which had brought about the action of the Patent Office in holding the claims 68 to 88 as being allowable. The destruction of petitioner's affidavits was accomplished by falsely alleging that Grant's experience and the experience of Helene Curtis in its production of hair waving compositions was in direct conflict with the affidavits filed by petitioner in September 1946 (D.A. E690-91, D.A. 662). The Patent Office Examiner could not believe the allegations of the protest which were under oath and the allegations of petitioner's affidavits. For *18* months the Examiner had accepted the

truthfulness of petitioner's affidavits and had indicated claims 68 to 88 to be allowable. Then, shortly after receiving the protest, the Examiner reversed his prior holding with respect to these claims saying that *he did not believe the affidavits of petitioner* (D.A. 16B, 20B, 21B). The Patent Office Examiner cited no new prior art in support of his reversal of his prior decision. He simply reiterated the prior art of his June 1946 rejection which he had declined to accept as controlling when he declared an interference in February 1947 (D.A. 16B-19B).

The Master dismissed the counterclaim of petitioner which alleged a malicious interference with petitioner's business relations based on the foregoing facts (D.A. 3071). This action was approved by the District Court (D.A. 3265). The Court of Appeals affirmed the action below solely on the basis of a failure of proof of causation between the alleged misconduct of respondent Helene Curtis and petitioner's injury. That court found that there was no evidence that the Patent Office had informally indicated that any of petitioner's claims were allowable (p. 24a). This was shown to be clearly erroneous, by petition for rehearing, in that it ignored both the undisputed facts and the law. Nevertheless, the Court of Appeals did not correct this error.

With respect to the counterclaim against Helene Curtis the Master found, "The underlying facts are not disputed, but only the inferences to be drawn therefrom" (D.A. 3052). The evidence before the Courts below was either documentary or undisputed oral testimony. Since the counterclaim has been established by undisputed evidence the errors of the lower Courts denying relief requires an exercise of the corrective jurisdiction of this Court.

Court of Appeals Erred in Holding No Causation

The Court of Appeals held that "Prior to the filing of this protest, there was nothing in the record to show that the application had been either formally allowed or informally indicated as allowable" (p. 24a).

In making this finding the Court of Appeals ignored the undisputed fact that the Patent Office made a declaration of interference between the application for the patent in suit and the Martin application (D.A. 15B). This holding of the Court of Appeals also ignored the requirements of 35 USC 135 and 37 Code of Federal Regulations 1.201(a) and (b) issued pursuant to the provisions of 35 USC 135. The provisions of 35 USC 135 set forth the conduct required of the Patent Office in the event of an interference. The provisions of 37 CFR 1.201(a) and (b) require that a determination of the existence of common patentable subject matter be made by the Patent Office in two or more applications before declaring an interference.

In view of the fact that an interference was declared by the Patent Office it is inescapable that such action constituted a holding by the Patent Office that the application for the patent in suit contained patentable subject matter. The Court of Appeals' interpretation ignores the requirements of the above cited statute and regulations.

The Court of Appeals' error appears in its statement: "But certainly the fact that Claim 88 was thought to be in interference carried not the slightest implication that the Examiner considered all the other, non-interfering, claims to be allowable" (p. 27a).

The undisputed record evidence shows that the Patent Office prior to the protest notified the applicant for the patent in suit that "Claims 68 through 87 (all the claims) will be held subject to rejection as unpatentable over the

issue in the event of an award of priority adverse to the applicant" (D.A. 15B). The undisputed evidence shows that this quoted language meant that claims 68 through 87 were not patentably distinct from claim 88, so that if McDonough was not the first inventor these claims would not be patentable by him. These claims involved the same subject matter as claim 88 which had been held to disclose patentable subject matter common to the Martin application. If Martin was the first inventor, as stated in the above quoted language, claims 68 through 87 would be rejected because McDonough was not the first inventor. Thus claims 68 through 87 were indicated by the Patent Office to be allowable.

The uncontradicted testimony of Conder C. Henry, versed in Patent Office practice and procedure through thirty years' service from Assistant Examiner to Assistant Commissioner of Patents, established that this language required the Patent Office:

> "To finally reject the only claim constituting the Count of the interference and immediately pass the case to issue on the remaining claims (68 to 87 of McDonough's application) which previously had been adjudged to be allowable" (D.A. 2782-2783).

In the case of *Wolfender* v. *Price*, 1898 Commissioner Decisions 87; 83 Official gazette 1801, the language used in the instant case was employed almost verbatim to notify the party of the existence of allowable claims. It was said,

> "* * * If the examiner is of the opinion that there is no patentable invention in these claims over the subject matter of the issue, it would be better practice for him to notify Wolfender's attorney that *in the event of the interference being determined adversely*

to him such claims would stand rejected as involving no patentable invention." * * * (Emphasis added) *idem* 88-89.

In spite of this meaning as interpreted by the Patent Office itself, and despite the undisputed sworn testimony of the witness Henry, the Court of Appeals held:

(1) No evidence in record that the claims were either formally allowed *or informally indicated* as allowable and

(2) Only claim 88 (count in interference) was considered allowable.

The lower court's error in ignoring both the law and the undisputed facts requires this Court to exercise its corrective powers as was done by this Court in *United States* v. *United States Gypsum Co.*, 333 U. S. 364. All the requirements for review based on the "clearly erroneous" rule are met by the erroneous holdings of the Courts below and there unquestionably is present the "definite and firm conviction that a mistake has been committed"—333 U. S. 395. The law and the facts establish that these holdings of the Courts below cannot stand.

In addition to the foregoing undisputed facts establishing that the Patent Office had determined that the application contained allowable claims (68-87) the lower courts completely ignored the unqualified and unequivocal admissions of the respondent Helene Curtis.

The undisputed evidence establishes that the protest authored and filed by Helene Curtis' Vice President and patent attorney contained the following admissions with respect to the claims of the McDonough application:

(1) "* * * Also voluntarily disclosed to said Samuel Grant and his attorney at that time were *some of the other claims that were declared to be allowable* in the McDonough, et al application. Two of said allowable claims are as follows * * *" (Here followed two composition claims, No. 81 a specie claim and No. 68, a generic claim) (D.A. E663)

(2) "* * * Helene Curtis Industries, Inc. and Samuel Grant hereby assert that the claim forming the single Count of the Interference, *as well as the other claims* of the McDonough et al application, are not patentable in that * * *" (D.A. E663-64)

(3) "* * * It is submitted that all of the allowed claims of the McDonough application are clearly anticipated * * *" (D.A. E673)

(4) "* * * It is respectfully submitted that *the claims* of the McDonough et al application *now standing allowed* * * *" (D.A. E680)

Thus, respondent Helene Curtis concurs that the law and facts showed that the claims of the McDonough application were indicated by the Patent Office to be allowable.

The Court of Appeals, the lower Court, and the Master never mentioned these undisputed facts. By erroneously holding that the Patent Office had never allowed McDonough's claims (at least informally) the lower courts were able to conclude that the Helene Curtis' illegal and false protest had done petitioner no harm.

That this Court does not review evidence in determining the propriety of exercising jurisdiction on a petition for Certiorari is well known. However, where the legal process of the administration of justice has been flagrantly abused by the lower Courts who omitted to consider un-

disputed facts and rights arising therefrom after such facts had been called to their attention, the exercise by this Court of its corrective powers is properly invoked. This Court has held where the evidence is undisputed the matter of causation may properly become a matter of law for the Court—*Brady* v. *Southern Ry. Co.*, 320 U. S. 476. The Court of Appeals' assertions that this record, in the light of the above undisputed facts, does not sustain causation is tantamount to saying that "black is white". This Court in the exercise of its supervisory jurisdiction on certiorari should correct such a manifest error.

The Helene Curtis Protest Contained Misrepresentations

The lower Courts never at any time discussed the misrepresentations relating to the falsity of the allegation in the protest that Helene Curtis produced hair waving compositions in a range of pH from 7 to 12 when in fact its pH was about 9.2, the precisely preferred pH of petitioner's application and never at a pH above 10, nor those relating to the false results of experiments conducted by Grant although they were alleged in the counterclaim (D.A. 44-45, 53) and established by undisputed evidence (D.A. E690-91, E438; D.A. 715, 512, 662, 717, 533; D.A. 707-709; D.A. E695-96, DX 232; D.A. 699, DX 233; D.A. E697, E691; D.A. 683, 695, 698-99).

The facts are undisputed and there is only one legitimate inference and that is that the Examiner changed his mind because of the misrepresentations contained in the *ex parte protest.*

The Master and the District Court both held that McDonough's activity in seeking a dissolution of the interference caused the change. McDonough's conduct was lawful, Helene Curtis' conduct was unlawful. It is a familiar principle that where a wrongful act would natu-

rally, according to the natural course of events, prove injurious and does actually produce injury through the interaction of it and innocent causes the injury is referred to the wrongful cause passing by those that are innocent. But McDonough's conduct had no relation to the change of the Examiner's mind. What the Examiner said and did are the determinative factors. The lower Courts ignored this and rested their determination on speculation and conjecture as to why the Examiner changed his mind.

The Master ignored those misrepresentations established by undisputed evidence and held that a little false swearing is to be expected from *ex parte* protestants in the Patent Office (D.A. 3055). This is inconsistent with the rule laid down by this Court in *Dorsey* v. *Kingsland*, 338 U. S. 318, where the Court said:

> "* * * the relationship of attorneys to the Patent Office requires the highest degree of candor and good faith. In its relation to applicants the Office * * * must rely upon their integrity and deal with them in a spirit of trust and confidence." *idem* 319

This Court should settle once and for all that parties filing protests in the Patent Office must let all candor and fairness characterize their dealings particularly in view of the fact that such protests are made *ex parte* and without notice of any kind to the applicant for a patent, 37 C.F.R. 1.291.

From the foregoing it is apparent that the lower Courts so departed from the accepted course of judicial procedure in ignoring the law and the facts as to require an exercise of the corrective jurisdiction of this Court.

Reasons for Allowance of the Writ

Petitioner's prayer for a writ of certiorari should be granted for the following reasons:

1. Oral argument was denied below under circumstances amounting to deprivation of constitutional due process. Protective definition of this basic right by this Court is of importance to all litigants.

2. The decision below is in direct conflict with a District of Columbia decision on the same patent leaving the Patent Office and a large industry in a state of uncertainty.

3. The holdings below are contrary to public policy as to important points of patent law, requiring correction by this Court to prevent retardment of science and the useful arts.

4. The cases herein directly raise issues of great importance to the administration of the patent laws by the Patent Office and lower courts which require definitive determination by this Court.

5. The lower courts departed from the accepted course of judicial procedure in ignoring undisputed evidence, admissions and statutes requiring exercise of the corrective jurisdiction of this Court.

CONCLUSION

For the foregoing reasons, petitioner respectfully requests that this petition for a writ of certiorari be granted.

Respectfully submitted,

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